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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,539	11/03/1999	JAMES N. VINCI	EJ464624279U	1217

7590 12/19/2002
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EXAMINER

TOOMER, CEPHIA D

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/19/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-16

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 6/7/2002

This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 6, 8-12 and 14-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 6, 8-12 and 14-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 13
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

This Office action is in response to the amendment filed June 7, 2002 in which claims 4, 5, 7 and 13 were canceled and claims 1, 10 and 17 were amended.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment to the claims.

The rejection of the claims under 35 USC 102(b) as anticipated by or in the alternative, under 35 USC 103(a) as obvious over Hollinghurst or Di Biase is withdrawn in view of the amendments to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 8-12, 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichihashi (5,792,731).

Ichihashi teaches a lubricant composition for transmissions comprising a phosphorus-based extreme pressure agent and an alkaline earth metal-based detergent (see abstract).

The phosphorus-based compound may be a phosphite of the formula $(RO)_3P$ wherein R is a C_3 - C_{30} alkyl or C_6 - C_{30} aryl (see col. 3, line 55 through col. 4, lines 1-20).

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The phosphite is present in the composition in an amount from 0.05-5 wt.% (see col. 4, lines 64-67).

The alkaline earth metal-based detergent may be a carboxylic acid acylating agent such as, a salicylate (see col. 5, lines 4-11). The TBN of the detergent is in the range of 80-350 mg KOH/g. The detergent is present in the composition in an amount from 0.05 - 8 wt% (see col. 5, lines 4-25). The composition of Ichihashi meets the limitations of the claims regarding the ratio of equivalents because the equivalents of the overbased material is for 160-701 and the equivalents of the phosphite is such that the ratio of overbased material to phosphite is at least one.

Ichihashi teaches that the composition of his invention may contain ashless dispersants such as borated amines (boron-containing benzylamine), and amides of fatty acids (see col. 6, lines 17-21).

Accordingly, Ichihashi teaching all the limitations of the claims, anticipates the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

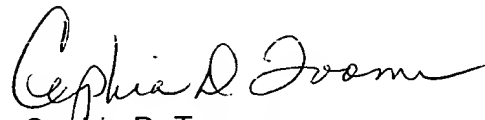
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, reading "Cephia D. Toomer".

Cephia D. Toomer
Primary Examiner
Art Unit 1714

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December 18, 2002